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POPHAM, JEFFREY D

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES E. KING, STEPHEN C. EVANS,
and MARTIN P. MAYHEAD

Appeal 2007-3351
Application 09/930,113
Technology Center 2100

Decided: May 27, 2008

Before JAMES D. THOMAS, JOSEPH L. DIXON, and JAY P. LUCAS,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-31. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and enter a NEW GROUNDS OF REJECTION under 37 CFR § 41.50(b).

BACKGROUND

Appellants' invention relates to secure network identification. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A processing unit connectable to a data communications network, the processing unit having a device reader for a portable storage device that includes storage operable to supply a network identity of the processing unit and an access controller, the access controller being operable to prevent unauthorized writing to the storage, the processing unit being operable before reading the network identity from the portable storage device, to attempt a write to the storage of the portable storage device, and, on determining that the write has failed, to read the supplied network identity.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Hellman	US 4,200,770	Apr. 29, 1980
Walters	US 5,357,573	Oct. 18, 1994
Hastings	US 5,460,441	Oct. 24, 1995
Braithwaite	US 5,644,444	Jul. 1, 1997
Combaluzier	US 5,973,475	Oct. 26, 1999
Teppler	US 6,792,536 B1	Sep.14, 2004
Merrien	PCT No. WO9857474	Dec. 17, 1998
(Translation dated Oct. 2004)		

MacDonald, D., "Windows NT Server, Microsoft Windows NT® 5.0 TCP/IP Implementation Details TCP/IP Protocol Stack and Services", Oct. 7, 1998.

REJECTIONS

Claims 1, 4, 10, 13, 15, 20, 23, 25, 26, 29, and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters.

Claims 2, 11, and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Braithwaite.

Claims 3, 12, 22, 27, and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Hellman.

Claims 5, 14, 24, and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of MacDonald.

Claims 6, 7 and 16-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Combaluzier.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Teppler.

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters, further in view of Hastings.

Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Merrien in view of Walters and Combaluzier, further in view of Teppler.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Dec. 8, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Jul. 25, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 103(a)

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to

known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

With respect to independent claim 1, we find the Examiner's rejection in the Answer at pages 4-5 and 14-17 to set forth a sufficient initial showing of the obviousness of independent claim 1. Therefore, we look to Appellants' Brief to identify error in the Examiner's initial showing or to present evidence of nonobviousness.

Appellants' first argument is that there is no suggestion or motivation to combine the references and that the Examiner has relied upon improper hindsight reconstruction. (App. Br. 7-8). Appellants' argument relies mainly upon the asserted lack of an express statement of how to combine the elements of Merrien and the elements of Walters to produce the claimed

invention without further explanation by Appellants. We find Appellants' argument to be unpersuasive of error in the Examiner's initial showing. In the rejection, the Examiner relies upon the teachings of Merrien to set forth a hardware configuration with a portable storage device as recited in the language of independent claim 1. The Examiner further relies upon the teachings of Walters with respect to the processing unit being operable before reading the "network identity" from memory to attempt to write to the storage device and on determining that the write has failed, to read the supplied "network identity." Here, the Examiner equates the protection code of Walters to be equivalent to or suggestive of any "network identity." We find that the teachings of Walters clearly would have been suggestive to an artisan of a write then read sequence of steps with regard to information stored therein. Here, Appellants appear to read additional limitations into the "network identity" limitation and to interpret the limitation in a more restricted context than recited in the language of independent claim 1. The Examiner has maintained that the motivation to combine the teachings of Walters with those of Merrien is "in order to verify that the car input to the system was an approved car that could be used with the system." (Ans., 5). We agree with the Examiner's conclusion concerning the combinability of the teachings of Merrien and Walters concerning a "processing unit" with a mere intended field of use of being connectable to a communication network. Therefore, we do not find Appellants' argument concerning a lack of motivation to be persuasive of error in the Examiner's initial showing.

The Appellants further assert that there is no reasonable expectation of success and that the references teach away from each other. (App. Br. 8). We disagree with Appellants and find no express teaching in either reference of going a divergent way than the other references teach. Appellants attempt to distinguish the teachings of Merrien with respect to an IP address which is used outside a computer in a network and the teachings of Walters with respect to a protection code which is used internal to the computer system. (App. Br. 8). We find no distinction since both codes or identifications are produced with respect to a processing unit as recited in independent claim 1. We find no support in the language of independent claim 1 for Appellants' implied distinctions. Therefore, we find no "teaching away" as advanced by Appellants. Therefore, this argument is not persuasive of error in the Examiner's rejection of independent claim 1.

With respect to Appellants' argument that the protection code of Walters does not supply a "network identity" usable for access to a data communication network by a processing unit, we find no express support in the language of independent claim 1 for this argument. (App. Br. 9). Therefore, this argument is not persuasive of error in the Examiner's rejection of independent claim 1.

Appellants argue that there is no suggestion in Walters that verification of the protection code permits the reading of "arbitrary data" from the card as maintained by the Examiner in the Final office action. (App. Br. 9). We do not find Appellants' argument relevant to the instant claimed limitation since the claim language of independent claim 1 does not

require the reading of “arbitrary data.” Therefore, this argument is not persuasive of error in the Examiner's rejection of independent claim 1. Since Appellants have not shown error in the Examiner's initial showing of obviousness, we will sustain the rejection of independent claim 1 and dependent claim 4 which has been grouped therewith by Appellants. Additionally, Appellants have elected to group independent claims 10, 20, and 25 with independent claim 1 and respective dependent claims 13, 15, 23, 26, 29, and 30. Therefore, we also sustain the rejections of those claims for the same reasons.

With respect to the second through eighth grounds of rejections (App. Br. 9-13), Appellants rely upon the arguments advanced with respect to independent claim 1. Since Appellants did not show error in the Examiner's initial showing of obviousness with respect to independent claim 1, we similarly find no showing of error with respect to the enumerated dependent claims. Therefore, we also sustain the rejections of those claims for the same reasons.

NEW GROUNDS OF REJECTION

We first reject claims 18 and 19 as being directed to hybrid claims and therefore indefinite with 35 U.S.C. § 112, second paragraph. These claims all involve different statutory classes of invention and are necessarily indefinite to the extent they recite more than one statutory class of invention. Dependent claims 18 and 19 purport to set forth an apparatus environment

but rely upon the claimed subject matter of process (computer program per se) in independent claim 10 on appeal. (See *Microprocessor Enhancement Corp. v. Texas Instruments, Inc.*, 520 F.3d 1367, (CAFC, April 1, 2008))

We also reject claims 10 through 17 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Independent claims 10 recites a computer program per se disassociated with any machine or article of manufacture. Independent claim 10 fails to recite a machine implemented method or otherwise require operation upon or alteration of physical things to a different state or thing. There is also no machine recited within independent claim 10 to perform the data transformation and operations required by these claims. The steps of independent claim 10 are directed to a computer program per se. As evidence thereof, dependent claim 15 further recites "the control program of claim 10 on a carrier medium." Therefore, independent claim 1 is not required to be on any tangible or computer readable medium. With respect to dependent claims 11, 14, 16, and 17, we do not find these limitations to further limit the disassociated computer program to an article of manufacture or a machine. Therefore, claims 10-14, 16, and 17 are directed to non-statutory subject matter.

Additionally, we find that dependent claim 15 is directed to the recited computer program steps on a carrier medium where the Specification at page 7, line 3 sets forth the carrier medium by way of various examples. The Specification sets forth "storage and telecommunication medium" as examples of the carrier medium. Since a generic telecommunications medium may be directed to merely an electromagnetic signal, we further

find dependent claim 15 to additionally be directed to non-statutory subject matter for this reason.

In summary, we have affirmed the Examiner's rejections of claims 1-31. We have also introduced new grounds of rejection as to claims 18 and 19 under the second paragraph of 35 U.S.C. § 112 and of claims 10-17 under 35 U.S.C. § 101.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 CFR § 41.50(b)

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